PATENT APPLICATION
DOCKET NO. 10012446-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Travis J. Parry

SERIAL NO.: 09/925,650 **GROUP ART UNIT:** 2626

FILED: August 10, 2001 **EXAMINER:** Wallerson, Mark E

SUBJECT: Direct Printing from Internet Database

APPELLANTS'/APPLICANTS' REPLY BRIEF

The Appellant filed an opening brief on revised opening brief on April 24, 2006. The Examiner responded in an answer mailed September 28, 2007. The following is a reply to the Examiner's answer. It is noted that the Appellant has also filed a revised opening brief on November 14, 2007 in response to a notice of non-compliance mailed October 19.

1. GROUNDS FOR REJECTION TO BE REVIEWED.

Grounds for Rejection A – Claims 1-10, 17, 18, 22, 23, 24, 25, and 26 stand rejected under 35 USC §102 as being anticipated by USPN 6,357,324 issued to Tabata

Grounds for Rejection B – Claims 11, 12, 13, and 14 were rejected under U5USC §103 as being unpatentable over Tabata in view of USPN 6,375,078 issued to Russell.

Grounds for Rejection C – Claims 15 and 16 stand rejected under 35 USC §103 as being unpatentable over Tabata in view of USPN 5,848,413 issued to Wolff.

2. ARGUMENT.

A. Claims 1-10, 17, 18, 22, 23, 24, 25, and 26 stand rejected under 35 USC §102 as being anticipated by USPN 6,357,324 issued to Tabata

Claim 1 is directed to a printing method and recites the following acts:

1. receiving print stream data adapted to contain a network address, at a printer;
2. determining, at the printer, whether a URL or external network option is enabled;
3. detecting at the printer if a network address is in the received data;
4. sending on the Internet or other network, an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;
5. retrieving the document from the network address at the printer in the instance the administrative control entity grants the access request;
6. merging, at the printer, the document from the network address into the

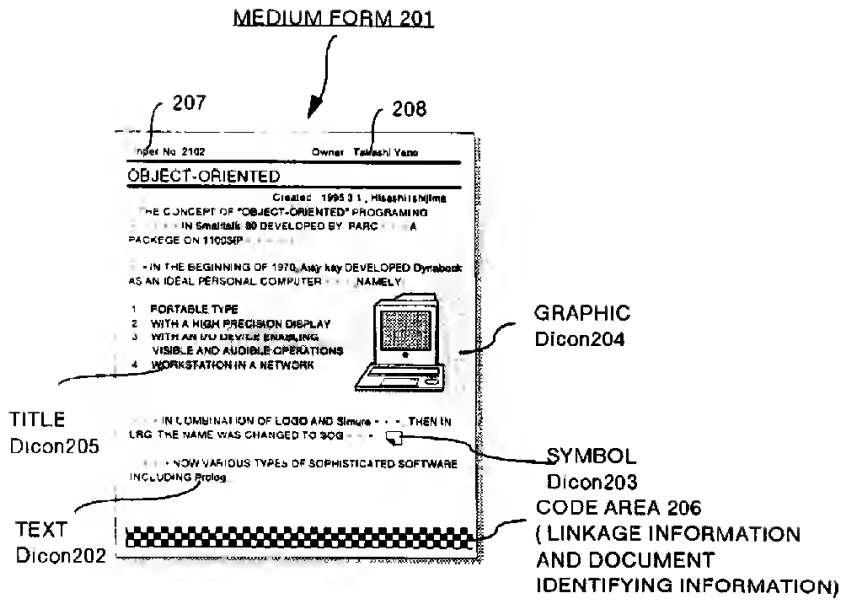
print stream data to form a modified document; and

7. printing the modified document.

In the opening brief, the Appellant explained that Tabata fails to teach or suggest merging, at a printer, a document into print stream data (received at the printer) to form a modified document where the document being merged into the print stream data was obtained at the printer from a network address detected in the print data stream data in the manner recited by Claim 1.

At page 7 and 8 of the answer, the Examiner disagrees with the Appellant's explanation. Before addressing the Examiner's position, an reiteration of Tabata's teachings is helpful. Tabata discloses a system for utilizing printed physical documents as if they were web pages displayed on a computer screen. Tabata labels this concept PUI or Paper User interaction. *See, e.g.,* Tabata, col. 7, line 56 through col. 8, line 14. Such a printed document is referred to as medium form (201, 420) where medium form information is the printed information on the medium form (201, 420). *See* Tabata, col. 8, lines 31-58 (describing medium form information), and Tabata, col. 5, lines 47-57 (describing medium form information), and Fig. 2, reproduced below.

FIG.2



A printed medium form (201, 420) is produced from a hypertext document. Tabata, col. 6, lines 26-37. The medium form (201) includes dicons (204) – (205) and a code area (206). Tabata, col. 8, lines 31-58. Dicons (204) – (205), also referred to as "described information" are text or images printed on medium form (201, 420) that serve as the functional equivalent of a hyperlink included in a web page. *See, e.g.,* Tabata, col. 8, line 59 through col. 9, line 57. A dicon can take the form of text, an icon, or a graphic. Tabata, col. 9, lines 18-31. The linkage information encoded in code area (206) links or otherwise associates each dicon with a "correlated information file." *See* Tabata, col. 10, line 8-53 and Fig. 7.

Referring to Tabata's Figures 20 and 21, Tabata teaches that the medium form (420) can be scanned by a scanner (430) coupled to a computer (440) or the medium form can be scanned by a printer/copier (470). Both computer 440 and printer 470 are equipped to (a) identify a mark (51) that was manually added to the medium form, (b) identify a dicon (203-205) that is associated with that mark (51), (c) identify an address

for retrieving a correlated information file from that address, and (d) print that correlated information file. *See* Tabata, col. 23, line 64 through col. 24, line 17.

To summarize, the address for retrieving the correlated information file can be obtained from the scanned medium form (420) by Tabata's printer (470). Tabata's printer (470) can also retrieve that correlated information file using the obtained address. However, Tabata's printer simply prints the correlated information file and/or a new medium form. The new medium form is created and printed if the retrieved correlated information file is a hypertext. Tabata's printer (470) does not merge the retrieved correlated information file into the original medium form (420). Assuming that Tabata's scanned medium form (420) can be equated with the print stream data recited in Claim 1, the correlated information file retrieved using information from that scanned medium form is **not** merged back into the print stream data to create a modified document as would be required by Claim 1. As such a modified document is not created or printed in the manner recited by Claim 1.

Addressing, the Appellant's arguments at pages 9 and 8 of the answer, the Examiner states:

> With regard to applicant's argument that Tabata's medium form information is not merged with anything, let alone a document retrieved form a detected address. Examiner disagrees with Appellant's conclusion. Examiner pointed to col. 30, lines 60-67 of Tabata, to teach that the medium form information is synthesized with retrieved data and added selected information. Col. 3, lines 1-15, and col. 5, lines 34-40, described how the retrieved information can be synthesized with additional information selected by the user.

The various passages cited by the Examiner discuss "synthesizing." However, this synthesizing does not refer to merging a retrieved document into a print stream data to form a modified document in the manner recited by Claim 1. Tabata uses the term synthesizing as an overall label to describe the steps take to create a medium form (201) from a hypertext. The passages speak of creating a medium form (201, 420) by synthesizing image extraction information, described information, and linkage

information taken from a hypertext. The passages mention nothing of merging a retrieved document (correlated information file) into print stream data (scanned medium form).

The following illustrates the Examiner's misapplication of Tabata's teachings. The passages relied upon by the Examiner teach that a medium form (201, 420) is created by synthesizing image extraction information, described information, and linkage information. As discussed above, a mark (51) can be added to a printed medium form (201, 420). The marked form can then be scanned, a dicon associated with the mark can be identified, and an address corresponding to the identified dicon can be discerned. The identified dicon is associated with a correlated information file that can be retrieved from the discerned address. Once retrieved, the correlated information file is printed. If the correlated information file is a hypertext, a new medium form can be created by synthesizing image extraction information, described information, and linkage information obtained from that hypertext.

Plainly the term synthesizing as used does not refer to merging a retrieved correlated information file into a scanned medium form. The term refers to the creation of a new medium form which is not created by merging a document into print stream data to form a modified document.

For at least these reasons Claim 1 is patentable over Tabata as are Claims 2-21 which depend from Claim 1.

Claim 22 is directed to a program product comprising a computer readable medium having machine readable program code for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so are Claim 22 and Claims 23 which depends from Claim 22.

Claim 24 is directed to a program product, including machine readable program code for causing a machine to carry out the following method steps:

1. receiving print stream data at a printer;
2. determining, at the printer, whether a URL or external network option is enabled;
3. detecting, at the printer, if a network address is included in the received data;
4. sending on the Internet or other network an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;
5. retrieving, at the printer, the document from the network address in the instance the administrative control entity grants the access request;
6. merging, at the printer, the document from the network address into the print stream data to form a modified document; and
7. printing the modified document; and
8. further comprising program code for performing, at the printer, the step of enabling/disabling the URL or external network access option.

Like Claim 1, Claim 24 recites limitations in which, at a printer, a document is merged into print stream data (received at the printer) to form a modified document where the document being merged into the print stream data was obtained at the printer from a network address detected in the print data stream data. As made clear above, Tabata doe not teach or suggest such limitations.

For at least the same reasons Claim 1 is patentable, so is Claim 24.

Claim 25 is directed to a printing method and recites the following acts:

1. determining if a network address is contained in print stream data received at a printer;
2. determining, at the printer, whether a URL or external network option is enabled;

3. sending on the Internet or other network an access request from the printer to control entity separate and distinct from an entity instigating the print stream data, for a document to the network address;
4. retrieving, at the printer, the document from the network address in the instance the administrative entity grants the access request;
5. merging, at the printer, the document from the network address into the print stream data to form a modified document; and
6. using the printer to printing the modified document.

Like Claim 1, Claim 25 recites limitations in which, at a printer, a document is merged into print stream data (received at the printer) to form a modified document where the document being merged into the print stream data was obtained at the printer from a network address detected in the print data stream data. As made clear above, Tabata doe not teach or suggest such limitations.

For at least the same reasons Claim 1 is patentable, so is Claim 25.

Claim 26 is directed to a program product including machine readable program code for causing a machine to carry out the following method steps:

1. determining, at the printer, if a network address is included in print stream data received at a printer;
2. determining, at the printer, whether a URL or external network option is enabled;
3. sending on the Internet or other network an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;
4. retrieving, at the printer, the document from the network address in the instance the administrative entity grants the access request;

5. merging, at the printer, the document from the network address into the print stream data to form a modified document; and
6. using the printer to printing the modified document.

Like Claim 1, Claim 26 recites limitations in which, at a printer, a document is merged into print stream data (received at the printer) to form a modified document where the document being merged into the print stream data was obtained at the printer from a network address detected in the print data stream data. As made clear above, Tabata doe not teach or suggest such limitations.

For at least the same reasons Claim 1 is patentable, so is Claim 26.

B. Claims 11, 12, 13, and 14 were rejected under U5USC §103 as being unpatentable over Tabata in view of USPN 6,375,078 issued to Russell.

Claims 11-14 each ultimately depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so are Claims 11-14.

C. Claims 15. 16, 19, 20, and 21 stand rejected under 35 USC §103 as being unpatentable over Tabata in view of USPN 5,848,413 issued to Wolff.

Claims 15, 16, and 19-21 each ultimately depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so are Claims 15, 16, and 19-21.

8. CONCLUSION.

In view of the foregoing remarks, the Applicant respectfully submits that the pending claims are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,
Travis J. Parry

By /Jack H. McKinney/
Jack H. McKinney
Reg. No. 45,685

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. (Previously presented) A printing method, comprising:

receiving print stream data adapted to contain a network address, at a printer;

determining, at the printer, whether a URL or external network option is enabled;

detecting at the printer if a network address is in the received data;

sending on the Internet or other network, an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;

retrieving the document from the network address at the printer in the instance the administrative control entity grants the access request;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

printing the modified document.

2. (Original) The method as defined in claim 1, wherein the external network address is a URL.

3. (Previously presented) The method as defined in claim 1, wherein the step of detecting a network address comprises detecting a barcode in the received data and translating the barcode to the network address.

4. (Original) The method as defined in claim 3, wherein, if the URL or other external access option is not enabled, then printing the untranslated barcode.

5. (Original) The method as defined in claim 1, further comprising the step of enabling/disabling the URL or external network access option.

6. (Previously presented) The method as defined in claim 1, further comprising the step of presenting a display to the administrative control entity to

enable/disable the URL or external network access option.

7. (Original) The method as defined in claim 6, wherein the display is provided from a printer driver.

8. (Previously presented) The method as defined in claim 1, further comprising the step of enabling/disabling the URL or external network access option from a control panel at the discretion of the administrative control entity.

9. (Original) The method as defined in claim 8, wherein the control panel is at the printer.

10. (Previously presented) The method as defined in claim 8, wherein the control panel is at a remote administrative control entity location.

11. (Previously presented) The method as defined in claim 10, further comprising the step of sending of a user name or password to the remote administrative control entity location.

12. (Original) The method as defined in claim 1, further comprising the step of automatically enabling/disabling the URL or external network access option based on a criteria.

13. (Original) The method as defined in claim 12, wherein the criteria is whether the URL or external network device meets a security requirement.

14. (Original) The method as defined in claim 13, wherein the security requirement is the receipt of an authorized user name and/or password.

15. (Original) The method as defined in claim 1, wherein said receiving data step comprises receiving an e-mail containing said data.

16. (Original) The method as defined in claim 1, wherein said receiving data step comprises receiving an e-mail with an attachment containing said data.

17. (Original) The method as defined in claim 3, wherein said translating step comprises translating the barcode to obtain a PIN#; and wherein said sending step includes sending the PIN# with the access request to the external network address for determining if the request is authorized.

18. (Original) The method as defined in claim 1, wherein the detecting a network address step comprises interpreting a wrapper indicating that the wrapped data is a barcode.

19. (Original) The method as defined in claim 3, wherein the translated barcode includes information on printing the document inside another document; and

further comprising the step of printing the document inside the other document in accordance with the printing information upon receipt of the document at the printer.

20. (Original) The method as defined in claim 1, further comprising the step of printing the document inside a master document.

21. (Original) The method as defined in claim 20, wherein the detecting of a network address step further comprises

obtaining at least one identifier that designates the type of contents in said document; and

determining a location of the document within the master document based on said identifier.

22. (Previously presented) A program product including machine readable program code for causing a machine to carry out the following method steps:

receiving print stream data adapted to contain a network address at a printer;

determining, at the printer, whether a URL or external network option is enabled;

detecting, at the printer, if a network address is in the received data;

sending on the Internet or other network an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;

retrieving, at the printer, the document from the network address in the instance the administrative control entity grants the access request;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

printing the modified document.

23. (Original) The program product as defined in claim 22, wherein program code for performing the detecting a network address step comprises program code for detecting a barcode in the received data and translating the barcode to the network address.

24. (Previously presented) A program product, including machine readable program code for causing a machine to carry out the following method steps:

receiving print stream data at a printer;

determining, at the printer, whether a URL or external network option is enabled;

detecting, at the printer, if a network address is included in the received data;

sending on the Internet or other network an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;

retrieving, at the printer, the document from the network address in the instance the administrative control entity grants the access request;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

printing the modified document; and

further comprising program code for performing, at the printer, the step of enabling/disabling the URL or external network access option.

25. (Previously presented) A printing method, comprising the steps of:

determining if a network address is contained in print stream data received at a printer;

determining, at the printer, whether a URL or external network option is enabled;

sending on the Internet or other network an access request from the printer to control entity separate and distinct from an entity instigating the print stream data, for a document to the network address;

retrieving, at the printer, the document from the network address in the instance the administrative entity grants the access request;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

using the printer to printing the modified document.

26. (Previously presented) A program product including machine readable program code for causing a machine to carry out the following method steps:

determining, at the printer, if a network address is included in print stream data received at a printer;

determining, at the printer, whether a URL or external network option is enabled;

sending on the Internet or other network an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;

retrieving, at the printer, the document from the network address in the instance the administrative entity grants the access request;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

using the printer to printing the modified document.